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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/667,425	09/23/2003	Tokunori Kato	117279	3122

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EXAMINER

WOO, STELLA L

ART UNIT	PAPER NUMBER
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2614

DATE MAILED: 07/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/667,425	Applicant(s) KATO ET AL.	
	Examiner Stella L. Woo	Art Unit 2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>01/13/2006</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 3, 6, 13, 15, 18-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Chang et al. (US 2002/0164003, hereinafter “Chang”).

Regarding claim 1, Chang discloses an IP telephone apparatus (telephone 130; Figures 9A, 9B) connected to a personal computer (PC 14) connected to a computer network (Internet 19), and having a telephone calling function (analog telephone circuit 136) and a network calling function (switching circuitry 137 includes SLIC 36, CODEC 37 and interface 38 for handling an Internet-based telephone call), the IP telephone apparatus comprising:

the IP telephone apparatus (130) is connected to the personal computer (PC 14) that is connected to the computer network (Internet 19),

a calling function detection unit (button 134 is used to toggle between an Internet-based telephone call and a PSTN network telephone call; paragraphs 72, 75-76); and

a calling function notification unit (LED lights 135 indicate whether the phone is set for PSTN or Internet-based telephony service; Figure 72).

Regarding claim 3, 6, 15, 18-19, telephone 130 includes one LED to indicate Internet-mode and a second LED to indicate PSTN-mode (Figure 9A).

Regarding claim 13, Chang additionally provides for a computer (PC 14).

3. Claims 1-5, 8, 11-17, 19-24 are rejected under 35 U.S.C. 102(e) as being anticipated by Jones et al. (US 6,404,764, hereinafter "Jones")

Regarding claims 1, 4, 13, 16, 19-24, Jones discloses an IP telephone apparatus (telephony subsystem 34; Figure 5) having a plurality of types of calling functions including a telephone calling function (POTS interface 40) and a network calling function (IP telephony interface 44), the IP telephone apparatus comprising:

the IP telephone apparatus is connected to the personal computer (system controller 32 is a standard microprocessor-controlled computer system; col. 3, lines 20-24) that is connected to the computer network (Internet 12),

a calling function detection unit (incoming call handler detects whether a PSTN-based call or a VoIP-based call is received; col. 6, lines 1-18); and

a calling function notification unit (DTMF detection and call progress generator 52 informs the user whether the incoming call is a PSTN-based call or a VoIP-based call via a distinctive ringing cadence; col. 6, lines 19-29).

Regarding claims 2, 14, when a calling request is being made, DTMF detection and call progress generator 52 detects which calling function is selected based on the presence or absence of a sequence of predetermined signals (e.g. the “*#” keys) (col. 9, lines 27-41); and

when an incoming call is made, the DTMF detection and call progress generator 52 detects which calling function is selected (DTMF detection and call progress generator 52 informs the user whether the incoming call is a PSTN-based or VoIP-based call via a distinctive ringing cadence; col. 6, lines 19-29).

Regarding claims 3, 15, telephone handset 30 displays caller identification information which would indicate a VoIP-based telephone call (col. 10, lines 48-55).

Regarding claims 5, 17, when a calling request is being made, a slightly modified dial tone indicates an Internet-based call can be made, and a PSTN supplied dial tone indicates that only a POTS telephone call can be made (col. 5, lines 54-67).

Regarding claims 8, 11, Jones provides for a slave device (wireless handset 30; col. 9, line 66 – col. 10, line 38).

Regarding claim 12, Jones provides for simultaneous VoIP-based and PSTN-based telephone calls (col. 5, lines 1-53).

Regarding claim 13, Jones provides for a computer (system controller 32 is a standard microprocessor-controlled computer system; col. 3, lines 20-24).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 6, 9, 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones in view of Chang.

Jones differs from claims 6, 18 in that it does not specify two separate display units to indicate a network telephone operation and a general telephone operation. However, Chang teaches the desirability of providing a first LED to indicate an Internet telephony mode and a second LED to indicate a PSTN telephone mode (Figure 9A; paragraph 72) such that it would have been obvious to an artisan of ordinary skill to incorporate such LED display indicators, as taught by Chang, within the system of Jones in order to continually indicate which network is connected.

Regarding claim 9, Chang teaches that each of the cordless handset 132 and base station 131 includes a button 134 for toggling between the PSTN and Internet-based telephone service such that it would have been obvious to an artisan of ordinary skill to incorporate the two indicator LEDs 135 on the handset as well so that a user is informed of the telephone mode while using the handset away from the base station.

6. Claims 7 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones in view of Chang, as applied to claims 6 and 9 above, and further in view of Messel et al. (US 2004/0204125, hereinafter "Messel").

The combination of Jones and Chang differs from claims 7 and 10 in that it does not specify using different lighting colors. However, Messel teaches the well known use of different backlight colors to indicate particular events (paragraphs 22, 41, 49) such that it would have been obvious to an artisan of ordinary skill to incorporate the use of different backlight colors, as taught by Messel, within the combination of Jones and Chang as another means of indicating the different telephone modes.

Response to Arguments

7. Applicant's arguments filed May 5, 2006 have been fully considered but they are not persuasive.

Regarding the rejection of claims 1, 3, 6, 13, 15, 18-19 under 35 USC 102, Applicant argues that "[n]othing in Chang teaches that when the personal computer receives the access signal from the computer network indicating an incoming call the IP telephone apparatus is notified via the personal computer control signal." However, this feature is recited in claims 2 and 14, which were rejected as being anticipated by Jones, not Chang.

Applicant does not address how the claims are distinguished from the Jones patent.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stella L. Woo whose telephone number is (571) 272-7512. The examiner can normally be reached on Monday-Friday, 8:00 a.m. to 4:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curtis Kuntz can be reached on (571) 272-7499. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Stella L. Woo
Primary Examiner
Art Unit 2614